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## TRANSMITTAL FORM

(to be used for all correspondence after initial filing)

<b>TRANSMITTAL FORM</b> <i>(to be used for all correspondence after initial filing)</i>	Application Number	10/035,829	
	Filing Date	10/18/2001	
	First Named Inventor	Vlad J. Novotny	
	Art Unit	2874	
	Examiner Name	Unknown	
Total Number of Pages in This Submission	16	Attorney Docket Number	AONIP001C1

Total Number of Pages in This Submission

### ENCLOSURES (Check all that apply)

<input type="checkbox"/> Fee Transmittal Form <input type="checkbox"/> Fee Attached <input type="checkbox"/> Amendment/Reply <input type="checkbox"/> After Final <input type="checkbox"/> Affidavits/declaration(s) <input type="checkbox"/> Extension of Time Request <input type="checkbox"/> Express Abandonment Request <input type="checkbox"/> Information Disclosure Statement <input type="checkbox"/> Certified Copy of Priority Document(s) <input type="checkbox"/> Response to Missing Parts/ Incomplete Application <input type="checkbox"/> Response to Missing Parts under 37 CFR 1.52 or 1.53	<input type="checkbox"/> Drawing(s) <input type="checkbox"/> Licensing-related Papers <input type="checkbox"/> Petition <input type="checkbox"/> Petition to Convert to a Provisional Application <input type="checkbox"/> Power of Attorney, Revocation <input type="checkbox"/> Change of Correspondence Address <input type="checkbox"/> Terminal Disclaimer <input type="checkbox"/> Request for Refund <input type="checkbox"/> CD, Number of CD(s) _____	<input type="checkbox"/> After Allowance communication to Technology Center (TC) <input type="checkbox"/> Appeal Communication to Board of Appeals and Interferences <input type="checkbox"/> Appeal Communication to TC (Appeal Notice, Brief, Reply Brief) <input type="checkbox"/> Proprietary Information <input checked="" type="checkbox"/> Status Letter <input checked="" type="checkbox"/> Other Enclosure(s) (please identify below): 1. Domestic Priority Claim Information to update the Filing Receipt - 4 pgs.
<b>Remarks</b> 2. Application Data Sheet - 2 pages. 3. Return Receipt Postcard		

### SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT

Firm or Individual name	Silicon Edge Law Group LLP, Arthur J. Behiel, Patent Attorney		
Signature			
Date	10/20/03		

### CERTIFICATE OF TRANSMISSION/MAILING

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Typed or printed name	Laurie Moreno		
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants: Vlad J. Novotny and Parvinder Dhillon

Assignee: Active Optical Networks, Inc.

Title: "MICRO-OPTO-ELECTRO-MECHANICAL SWITCHING SYSTEM"

Serial No.: 10/035,829 File Date: 10/18/01

Examiner: Unknown Art Unit: 2874

Docket No.: AON1P001C1 (AO-666)

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Domestic Priority Claim Information to Update the Filing  
Receipt

Dear Sir:

Applicants have amended the "Domestic Priority Claim and Continuity Information" on the enclosed Application Data Sheet in an attempt to comply with the new Patent Office requirements for indicating specified relationships between applications to claim the benefit of prior applications under 35 USC §120. Unfortunately, those new Patent Office requirements are vague and confusing, and contradict historic understanding as well as current and former laws and Patent Office rules. As such, applicants are unsure of how to characterize the various applications, and have amended the sections to appease the Patent Office but cannot

provide any assurance as to which of several unclear and contradictory relationship definitions the applications may assume.

For example, MPEP §201.07 (R1, Feb. 2003) states: "A continuation is a second application for the same invention claimed in a prior nonprovisional application and filed before the original prior application becomes abandoned or patented." However, MPEP §804, listing the requirements of double patenting rejections (including provisional rejections), states: "Where the claims of an application are substantively the same as those of a first patent, they are barred under 35 U.S.C. 101 - the statutory basis for a double patenting rejection. A rejection based on double patenting of the 'same invention' type finds its support in the language of 35 U.S.C. 101." Thus, according to the definition of continuation application provided by MPEP §201.07, no valid continuation of a patent can exist, in contrast to long-standing patent practice and many thousands of issued patents.

According to MPEP §201.08 (R1, Feb. 2003): "A continuation-in-part is an application filed during the lifetime of an earlier nonprovisional application, repeating some substantial portion or all of the earlier nonprovisional application and adding matter not disclosed in the said earlier nonprovisional application." This is in contrast to the Notice in the March 18, 2003 Official Gazette of the USPTO, which states: "the designation of an application as a continuation (rather than as a continuation-in-part) is an indication that the entire invention claimed in an application has support in the prior application, whereas the designation of an application as a continuation-in-part is an indication that the claimed

invention is not entirely supported by the prior application." In other words, to define a CIP the MPEP looks to whether an application has added subject matter, whereas the Official Gazette Notice directs applicants to determine whether the claimed invention is entirely supported by the prior application, without regard to whether subject matter has been added.

Neither 35 U.S.C §120 nor 37 CFR §1.78 requires the characterization of an application as a continuation versus a divisional versus a continuation-in-part. Perhaps for this reason, the MPEP in effect a few months ago made it clear that the terms "continuation," "CIP," "divisional," etc. had no legal significance. As stated in MPEP Edition 8, §201.11: "Continuing applications include those applications which are called divisions, continuations, and continuations-in-part. As far as the right under the statute is concerned the name used is immaterial, the names being merely expressions developed for convenience. The statute is so worded that the first application may contain more than the second, or the second application may contain more than the first, and in either case the second application is entitled to the benefit of the filing date of the first as to the common subject matter."

Given the vague, confusing and contradictory meanings proposed by the Patent Office, applicants are unsure what a "continuation application" is, what a "continuation-in-part application" is and what a "divisional application" is.

Applicants therefore resubmit their status letter and related papers mailed May 5, 2003, along with an updated Application Data Sheet.

Applicants therefore request the filing receipt "Domestic Priority Data as Claimed by Applicant" section to be updated with the information found in the accompanying Application Data Sheet.

Respectfully Submitted,



Arthur J. Behiel  
Reg. No. 39,603

I hereby certify that this correspondence is being deposited with the United States Postal Service as first-class mail in an envelope addressed to: Mail Stop, Commissioner for Patents, PO Box 1450 Alexandria, VA, 22313-1450, on October 20, 2003.

Laurie Moreno   
Name Signature